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In re Application of:

Ellenbogen et al.

Application No. 10/677,976

Filed: October 2, 2003

PGPUB: US20040120454A1 6/24/04.

Docket No.: 25960-009

OFFICE OF PETITIONS

: ON PETITION

This application has been referred to this office due to two communications filed July 21, 2005, by, *inter alia*, record counsel for applicants, which are being treated as (1) a petition under 37 CFR 1.78(a)(6) filed by counsel of record to accept an unintentionally delayed claim for benefit of a provisional application, (2) a petition under 37 CFR 1.183 filed by counsel of record for waiver of the requirement in 37 CFR 1.78(a)(6)(iii) for a statement that the entire delay in making the claim was unintentional, and (3) a petition under 37 CFR 1.181 (no fee) by counsel of record requesting entry and consideration of attached communications signed by counsel who is not of record and who does not allege that he is acting in a representational capacity for the named inventors, or for record assignee of the entire interest.

The petition filed by counsel of record under 37 CFR 1.78(a)(6) is **dismissed**.

The petition filed by counsel of record under 37 CFR 1.183 for waiver of the rules is **dismissed**.

The petition filed by counsel of record under 37 CFR 1.181 is **granted** to the extent that the aforementioned attached communications filed July 21, 2005, are being permitted to remain in the record, but is **dismissed** in that the USPTO will not take any action on, or otherwise consider, the third party communications.

With respect to the petition filed under 37 CFR 1.78(a)(6) by counsel of record:

A petition under 37 CFR 1.78(a)(6) is only applicable to those applications filed on or after November 29, 2000. Further, the petition is appropriate when the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application is submitted, or, as here, re-submitted after cancellation but also after expiration of the period specified in 37 CFR 1.78(a)(5)(ii) and must be filed during the pendency of the nonprovisional application. In addition, the petition must be accompanied by:

- (1) the reference required by 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(5)(i) to the prior-filed application, unless previously submitted;
- (2) the surcharge set forth in § 1.17(t); and
- (3) an adequate statement that the entire delay between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed was unintentional. The

Commissioner may require additional information where there is a question whether the delay was unintentional.

This petition lacks item (3) above, and as such, is dismissed.

BACKGROUND

Inspection of the record reveals that applicants included, on filing, in the unexecuted declaration a claim for benefit of provisional Application No. 60/415,391 ('391) which was filed on October 2, 2002. That benefit claim was recognized by the USPTO, notwithstanding that it was not included in either the first line of the specification or in an application data sheet as required by 37 CFR 1.78, as shown by its entry under the caption "Domestic Priority Data" on the filing receipt mailed December 29, 2003, the updated filing receipt mailed March 15, 2004, and the appropriate entry on corresponding U.S. Patent Application Publication No. US20040120454A1 published June 24, 2004. This circumstance is mentioned in MPEP 201.11, subsection D, which states that:

If an applicant includes a benefit claim in the application but not in the manner specified by 37 CFR 1.78(a) (e.g., if the claim is included in an oath or declaration or the application transmittal letter) within the time period set forth in 37 CFR 1.78(a), the Office will not require a petition under 37 CFR 1.78(a) and the surcharge under 37 CFR 1.17(t) to correct the claim if the information concerning the claim was recognized by the Office as shown by its inclusion on the filing receipt.

On February 26, 2004, applicants filed an executed declaration under 37 CFR 1.63 that repeated the claim for benefit.

Thus, while the reference to the '391 prior provisional application was not submitted in either the first line of the specification or in an ADS within the later of four months from the actual filing date of the instant application (which was February 2, 2004) or sixteen months from the filing date of the prior-filed provisional application (which again was February 2, 2004) as required by 37 CFR 1.78(a)(5)(ii), the claim was recognized by the USPTO.

However, on December 2, 2004, applicants filed: (1) another executed declaration under 37 CFR 1.63 that now lacked the claim for benefit, (2) a communication captioned "remarks" referring to the accompanying executed declaration, that specifically requested cancellation of the benefit claim per MPEP 201.11(G), and also referred to an accompanying request for a corrected filing receipt that lacked the benefit claim, and (3) a request for a corrected filing receipt that reflected cancellation of the benefit claim.

A corrected filing receipt was mailed by the USPTO on December 14, 2004, reflecting that the priority claim had been cancelled as requested by applicants on December 2, 2004.

On January 7, 2005, applicants requested that the USPTO not act on the documents filed on December 2, 2004, in that they were acting on instructions from a Massachusetts Superior Court.

On January 12, 2005, applicants filed a petition under 37 CFR 1.182 seeking to halt or undo their requested cancellation of the benefit claim, along with, for the first time, the amendment required by 37 CFR 1.78(a). The date that the required reference to the provisional application was first filed herein is January 12, 2005, by way of the supplemental amendment filed that date, which is far beyond the time periods set forth in 37 CFR 1.78(a).

The petition under 37 CFR 1.182 was dismissed as immaterial in the decision of April 22, 2005, and applicants were advised that if any relief were to be forthcoming, it would have to be sought under the provisions of 37 CFR 1.78(a)(6). Applicants were further advised, that, as noted in MPEP 201.11 subsection G, since the deliberate cancellation of the claim for benefit of the '391 application raised the issue of whether the delay in claiming benefit was unintentional, any forthcoming petition under 37 CFR 1.78(a)(6) should specifically address this issue.

OPINION

Petitioner has failed to carry his burden of proof to establish to the satisfaction of the Director that the entire delay in filing the amendment with the benefit claim in the above-identified application was "unintentional" within the meaning of 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(6).

The legislative history of Public Law 97-247, § 3, 96 Stat. 317 (1982), by which Congress first enacted the unintentional delay standard, reveals that the purpose, as embodied in 35 U.S.C. § 41(a)(7) was to permit the Office to have more discretion than in 35 U.S.C. 133 or 151 to revive abandoned applications in appropriate circumstances, but placed a limit on this discretion stating that "[u]nder this section a petition accompanied by [the requisite fee] would not be granted where the abandonment or the failure to pay the fee for issuing the patent was intentional as opposed to being unintentional or unavoidable." H.R. Rep. No. 542, 97th Cong., 2d Sess. 6-7 (1982), reprinted in 1982 U.S.C.C.A.N. 770-71. A delay resulting from a deliberately chosen course of action on the part of the applicant is not an "unintentional" delay within the meaning of 37 CFR 1.137(b). This standard is further discussed in MPEP 711.03(c), subsection II, C (1). In 1992 Congress extended the unintentional delay standard to the reinstatement of expired patents, set forth in 35 U.S.C. § 41(c). See Centigram Communications Corp. v. Lehman, 32 USPQ2d 1346, 1348-9 (DC EVa 1994). In 1999, by way of the American Inventor's Protection Act, Congress further extended the unintentional delay standard to apply to acceptance of: as here, belated claims for § 119(e) benefit of prior provisional applications, or belated claims for § 120 benefit of prior non-provisional applications, or belated notice required by §122(b) in a national stage application of a filing in a foreign country or under a multilateral international agreement; or a belated § 119(a)-(e), and (f), benefit claim of a filing in another intellectual property authority or country.

It is clear that the cancellation of the benefit claim on December 2, 2004, was a deliberate act, intentionally performed by way of not 1, but 3, separate communications signed by both applicants and their duly appointed counsel. Accordingly, by any reasonable interpretation of the "unintentionally delayed" requirement of 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(6), the delay in submission of the amendment for a benefit claim cannot be considered unintentional delay. The consequence of that deliberate waiver is, however, that the delay from that date until at least January 12, 2005, when applicants sought to reinstate that benefit claim, is not unintentional delay.¹ Thus the entire delay from February 4, 2004, when the amendment was due, until January 12, 2005, (and thereafter) is not unintentional due to applicants' deliberate cancellation of the claim on and after December 2, 2004. The reference to the prior provisional '391 application was not submitted in either the first line of the specification or in an ADS within

¹ Even here however, since applicants are acting involuntarily to reinstate the benefit claim as they are only acting pursuant to a court order; such is not seen to be an "unintentional" delay on their part. In other words, the period of intentional delay began on, and continues to run from, December 2, 2004.

the later of four months from the actual filing date of the instant application (which was February 2, 2004) or sixteen months from the filing date of the prior-filed provisional application (which again was February 2, 2004) as required by 37 CFR 1.78(a)(5)(ii). MPEP 201.11, subsection III D does not apply to the circumstance of, as here, a canceled benefit claim. The hiatus in the benefit claim arising from applicant's deliberate cancellation of that benefit claim means that there was no benefit claim to "correct" within the meaning of MPEP 201.11, subsection III D. While there had been a prior, timely, claim for benefit of the '391 application, that claim was cancelled on December 2, 2004. As such, there was no existing claim for benefit of the '391 application on and after December 2, 2004. Since, on and after December 4, 2004, there was no existing claim for benefit of the '391 application, there was no existing benefit claim that could be "corrected." Since the amendment proffered on January 12, 2005, to re-instate the canceled claim for benefit was not filed within the later of either 4 months from the instant filing date (i.e., February 2, 2004), or 16 months from the filing date of the '391 application (i.e., again, February 2, 2004), a grantable petition under 35 U.S.C. § 119(e) and 37 CFR 1.78(a)(6) is required as a condition of resurrecting that cancelled claim by way of the proffered amendment. See MPEP 201.11, Subsection V. In brief, MPEP 201.11 subsection III D does not speak to the instance, where, as here, a benefit claim has been deliberately waived by intentional cancellation. Rather, MPEP 201.11 subsection III G is controlling here:

A cancellation of a benefit claim to a prior application may be considered as a showing that the applicant is intentionally waiving the benefit claim to the prior application in the instant application. If the applicant later files a petition to accept an unintentionally delayed claim to add the benefit claim to the prior application in the same application from which the benefit claim was canceled, the Office may refuse to accept such benefit claim because the delay was not unintentional.

Indeed, if the submission of a claim for benefit of a given application is made for the first time outside the period required by 37 CFR 1.78(a)(5) or, as here, the re-submission or requested reinstatement of a canceled benefit claim of a given application, is likewise presented outside the period required by 37 CFR 1.78(a)(5), and each were properly construed to be a "correction" of a benefit claim that would not require a petition and fee, then it is difficult to imagine a situation where the petition and fee would ever be required. But see 35 U.S.C. § 119(e)(1) ("no application shall be entitled to the benefit of an earlier filed provisional application under this subsection unless an amendment... is submitted at such time during the pendency of the application as required by the Director. The Director may consider the failure to submit such an amendment within that time period as a waiver of any benefit under this subsection. The Director may establish procedures, including the payment of a surcharge, to accept an unintentionally delayed submission of an amendment under this subsection during the pendency of the application." Here, since the first time that the amendment required by both the relevant statute and regulation for a benefit claim was filed was January 12, 2005, which is beyond the time limits specified in 37 CFR 1.78(a), there can be no doubt that a grantable petition is required for the belated claim to now be accepted by the USPTO.

The December 2, 2004, filing of the 3 documents that requested cancellation of the claims, resulted in that there was no priority claim to cancel, this is simply inconsistent with the record, as the USPTO had, as provided for in MPEP 201.11, subsection III D, recognized their priority claim from the date the application was filed until it was expressly cancelled at applicants' request on December 2, 2004. That benefit claim was recognized by the USPTO, notwithstanding that it was not included in either the first line of the specification or in an application data sheet as required by 37 CFR 1.78, as shown by its entry under the caption "Domestic Priority Data" on the filing receipt mailed December 29, 2003, the updated filing receipt mailed March 15, 2004, and the appropriate entry on corresponding U.S. Patent

Application Publication No. US20040120454A1 published June 24, 2004, and applicants never contended that the USPTO had erred in recognizing the benefit claim. Indeed, the documents filed December 2, 2004, showed applicants' awareness of the prior USPTO recognition of their benefit claim, and expressly mentioned in 2 separate papers that such claim was now being expressly cancelled.

The subsequent order from the Massachusetts Superior Court does not excuse the delay herein in submission (or re-submission) of the benefit claim, nor does such convert the applicants' deliberate cancellation of the benefit claim on December 2, 2004, to the applicants' unintentional delay in filing the benefit claim amendment and seeking reinstatement of the benefit claim. Rather, the appearance of the court order is merely a change in circumstance that occurred subsequent to the express cancellation of the benefit claim and applicants' deliberate failure to maintain in force herein the benefit claim, which does not render "unintentional" the delay resulting from the previous deliberate decision to cancel the benefit claim. It is immaterial to the nature of the delay herein that the third party, or counsel for the third party, may not have agreed with, or was unaware of, cancellation of the benefit claim. Neither applicants nor the third party cannot undo the delay herein. The test is not whether some of the delay was unintentional on the part of any party; rather, the entire delay in submission of the benefit claim must be shown to the satisfaction of the Director to be unintentional.

With respect to the petition filed by counsel of record under 37 CFR 1.183 for waiver of the rules:

In order for grant of any petition under 37 CFR 1.183, petitioners must show (1) that this is an extraordinary situation where (2) justice requires waiver of the rule. In re Sivertz, 227 U.S.P.Q. 255, 256 (Comm'r Pat. 1985). Petitioners have not shown that either condition exists in this case.

Petitioners mention a request that the USPTO waive the express regulatory requirement that the "entire delay" was unintentional between the date the claim was due under 37 CFR 1.78(a)(5)(ii) and the date the claim was filed.² 37 CFR 1.183 by its express terms, is not

² The USPTO requires that the entire period of the delay be at least unintentional as a prerequisite to revival of an abandoned application to prevent abuse and injury to the public. See H.R. Rep. No. 542, 97th Cong., 2d Sess. 7 (1982), reprinted in 1982 U.S.C.C.A.N. 771 ("[i]n order to prevent abuse and injury to the public the Commissioner... could require applicants to act promptly after becoming aware of the abandonment"). The 1992 amendment to 35 U.S.C. § 41(c) which provided for reinstatement of expired patents upon a showing satisfactory to the Director that the nonpayment of the maintenance fee was unintentional, likewise indicated there was more discretion in reinstating a patent under the unintentional standard than under the unavoidable standard, but did not otherwise change or redefine the meaning of unintentional as already understood and applied to the revival of abandoned applications. Cf. 138 Cong. Rec. E 168 et seq. (June 4, 1992)(statement of Rep. McCollum). Likewise, the 1999 amendments to the patent statute to provide for acceptance of unintentionally delayed priority claims did not otherwise change or redefine the meaning of unintentional as already understood and applied to the revival of abandoned applications, and reinstatement of expired patents. Applying this same requirement as a prerequisite to the initial submission of a priority benefit request, or reinstatement of a earlier priority benefit request, likewise prevents abuse and injury to the public.

available to waive any requirement of the rules that is also a requirement of the patent statute. Here, however, the relevant statute requires that the amendment submitted January 12, 2005, can only be accepted if it: (1) was unintentionally delayed and (2) is submitted during the pendency of the application. See 35 USC 119(e)(1). While the statute does not expressly require that the entire delay have been unintentional, it is equally true that the statute does not expressly permit that only some of the delay be unintentional. Indeed, it is not seen, and petitioner does not show, how the submission of this or any amendment can be considered to be unintentionally delayed within the meaning of the statute and regulation if in fact any of the delay was not unintentional. As with the other sections of the patent statute embodying the unintentional delay standard, the USPTO also here requires that the entire delay be unintentional as a means of preventing abuse and injury to the public.

Accordingly, while condition 2 above has been satisfied, rule 183 is not here available to waive the other statutory requirement that the amendment in question must be "unintentionally delayed" in its submission. The USPTO simply has neither the discretion nor the power to relax any requirement of § 119(e)(1). See *Baxter Int'l, Inc. v. McGaw, Inc.*, 149 F.3d 1321, 1334, 47 USPQ2d 1225, 1234-1235 (Fed. Cir. 1998)(the USPTO cannot, by rule, or waiver of the rules, fashion a remedy that contravenes 35 U.S.C. §§ 112, 120); *A. F. Stoddard v. Dann*, 564 F.2d 556, 566, 195 USPQ 97, 105 (D.C. Cir 1977), (since the USPTO is an executive branch agency, it must follow the strict provisions of the applicable statute).

While petitioners did not expressly also seek waiver of the regulatory, but non-statutory, 4 or 16 month period of the rule for submitting (without a petition, fee, and statement of unintentional delay) an amendment adding or reinstating the canceled benefit claim, there is no basis given or apparent for granting such a request, notwithstanding the clear Congressional intent expressed in § 119(e)(1) for triggering a petition and fee for belated claims. See *Vincent v. Mossinghoff*, 230 USPQ 621, 625 (D.D.C. 1985)(petitioner's failure to heed published notice of USPTO procedures will not be permitted to shift, in equity, his lack of diligence onto the USPTO). Since the filing (or lack of filing) error noted above was entirely due to petitioners, and was not caused or contributed to by the USPTO, this case is even further removed from consideration as an "extraordinary situation" where "justice requires" an extraordinary remedy. See *Helfgott & Karras, P.C. v. Dickinson*, 209 F.3d 1328, 54 USPQ2d 1425 (Fed. Cir. 2000). Only after receipt of the court order, did petitioners seek retraction of their express waiver of the benefit claim by re-submission of that benefit claim. However, 37 CFR 1.183 should not be considered a panacea for an applicant's tactical errors in prosecution. See, *Nitto Chem. Indus. Co. v. Comer*, 39 USPQ2d 1778, 1782 (D.D.C. 1994) (circumstances are not extraordinary, and do not require waiver of the rules, when a party makes an avoidable mistake in filing papers); *Hahn v. Wong*, 892 F.2d 1028, 13 USPQ2d 1313 of (Fed. Cir. 1993)(ignorance of the provisions of the rules or the substantive requirements of law is not a basis for extraordinary relief to consider an additional submission).

With respect to the third party communications:

The communication signed by duly appointed counsel requests entry and consideration of the attached communications. Inspection of the attached communications reveals that (1) they are not signed by counsel duly appointed under 37 CFR 1.33, (2) they do not purport to be filed by any counsel acting in a representational capacity per 37 CFR 1.34(b) for either the named inventors or the record assignee, (3) make various arguments against the need for a petition under 37 CFR 1.78(a)(6), request clarification of the USPTO communication of April 22, 2005,

or alternatively, treatment of the attached communication as a "conditional" petition under the aforementioned regulation, and (4) request extraordinary relief under 37 CFR 1.182 or 1.183, if required. Indeed, the attached communications are filed on behalf of a party in litigation with the record assignee regarding ownership of this application.

For the reasons noted above, however, the attached communications signed by a counsel not of record and not acting expressly or impliedly in a representational capacity for either the record assignee, or for the named inventors, must be regarded as a third party communication with respect to this application. This is particularly so given the adversarial nature of the litigation noted above. However, the mere assertion in the attached communications of a right to have the Office act in accordance with the statutes and regulations does not confer standing upon the third party. The Boeing Company v. Commissioner of Patents and Trademarks, 853 F.2d 878, 7 USPQ2d 1487 (Fed. Cir. 1988). Further, a third party does not have standing to challenge Office decisions made *ex parte*. See, e.g., Godtfredsen v. Banner, 503 F.Supp 642, 647, 207 USPQ 202, 207 (D.D.C. 1980), Syntex v. United States Patent and Trademark Office, 882 F.2d 1570, 1574-1575, 11 USPQ2d 1866, 1870 (Fed. Cir. 1989), Hitachi Metals Ltd. v. Quigg, 776 F.Supp 3, 20 USPQ2d 1920 (Fed. Cir. 1989).

In Emerson Electric Co. v. Davoil, Inc., 88 F.3d 1051, 39 USPQ2d 1474 (Fed. Cir. 1996), the Federal Circuit held that a *federal* district court exceeded its authority in ordering a patentee to file a submission in the USPTO on behalf of a third party. Accordingly there is no adequately demonstrated need to further consider the third party papers herein, merely due to the accompanying request by applicants for entry and consideration thereof. Thus, whether the third party communications seek clarification of, or disagree with, the USPTO communication of April 22, 2005, or are self-styled as a "conditional" petition under 37 CFR 1.78(a)(6), or seek to invoke the extraordinary remedy provisions of the rules, is of no moment. There is nothing in the patent statutes which gives rise to a right in nonapplicants to object to the way in which patent applications of other inventors are treated by the Patent and Trademark Office. A third party has no right to intervene in a particular patent application. Animal Defense Fund v. Quigg, 932 F.2d 920, 930, 18 USPQ2d 1677, 1685 (Fed. Cir. 1991)("[w]e find nothing in the law which gives rise to a right in nonapplicants to object to the way in which patent applications of others are prosecuted."; Hallmark Cards, Inc. v. Lehman, 959 F. Supp. 539, 42 USPQ2d 1134 (D.D.C. 1997).

The Office has promulgated regulations permitting third parties to file protests and petitions for public use proceedings in applications that have not been published under 35 U.S.C. § 122(b) and 37 CFR 1.211 et seq. (37 CFR 1.291 and 1.292) and to file prior art submissions in applications that have been published under 35 U.S.C. § 122(b) and 37 CFR 1.211 et seq. (37 CFR 1.99). The rules of practice, however, do not permit a third party to petition the Office to accept an allegedly unintentionally delayed priority claim. That the Office does permit a third party to file certain papers in an application does not afford a third party with standing to challenge Office decisions made in that application. Cf. Boeing, supra (that a third party is permitted to participate in district court action concerning a reexamination proceeding does not imply that the third party has standing to appeal a district court decision favorable to patent owner). Caution is urged if contemplating the submission of any further papers herein in that the Office considers the filing of a petition or other paper on behalf of a party having no standing in an application, such as a third party, and not otherwise authorized by the rules of practice, to be a petition or paper presented for an improper purpose (37 CFR 10.18). For example, the filing of a paper on behalf of a party in situations not authorized by the rules of practice delays the examination and processing of applications, which may cause harm to the general public if it results in the Office missing any one of the examination time frames specified in 35 U.S.C. §§ 154(b)(1)(A) or 154(b)(1)(B). Therefore, the Office may refer any further

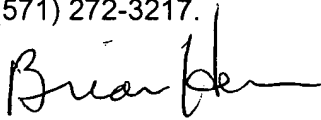
improper third party communication or petition in this or any other application to the Office of Enrollment and Discipline for appropriate action.

Since the petition under 37 CFR 1.78(a)(6) to accept the belated benefit claim has not been approved, per MPEP 1002.02(b), ¶ 5, by this office, the examiner necessarily remains without authority to enter the amendment submitted January 12, 2005, that seeks to re-instate the cancelled priority claim. The former benefit claim under § 119(e) remains deliberately waived and expressly canceled by the papers filed December 2, 2004, as indicated in the corrected filing receipt mailed December 14, 2004, and, as such, has no further force and effect.

As authorized, fees totaling \$1770 (\$400 for a petition under 37 CFR 1.183 and \$1370 for a petition under 37 CFR 1.78(a)(6)) have been charged to record counsel's deposit account. The fees were due regardless of the outcome of the decision.

This application is being referenced to the Technology Center.

Telephone inquiries related to this communication should be directed to the undersigned at (571) 272-3217.

A handwritten signature in black ink, appearing to read "Brian Hearn", with a stylized flourish at the end.

Brian Hearn
Petitions Examiner
Office of Petitions